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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,466	12/23/2003	Takeshi Ootsuka	P24111	8142
7055 7590 05/30/2008 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER TURCHEN, JAMES R				
ART UNIT		PAPER NUMBER		
2139				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/743,466

Applicant(s)

OOTSUKA ET AL.

Examiner

JAMES TURCHEN

Art Unit

2139

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-24, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-24, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 19-24, 27 and 28 are pending. Claims 19, 22, 23, 24, 27 and 28 are amended.

Response to Arguments

Applicant's arguments with respect to claims 19-23, 27 and 28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22, 24, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite "to select the first-watermark" and "to add the selected first watermark" but they fail to disclose what happens when both of the watermarks do not exist in memory and the first watermark is always added regardless of the presence of the first or second watermark. In addition, they present only the position that both watermarks exist in memory and if the first watermark does not exist, then the second watermark is selected and applied to the original.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wise (US 2002/0143649) in view of Kraslavsky (US 5,537,626).

Regarding claims 19 and 27:

Wise discloses a server connectable to a terminal apparatus and to a first printer via a network, the terminal apparatus being connected to a second printer, the server being not connected to the second printer, the server comprising:

a first memory configured to store original data without a watermark [*paragraphs 24 and 26, it is inherent that the original is stored in a memory*];

a second memory configured to store a watermark associated with a user ID of a user of the terminal apparatus, the second memory storing a plurality of the watermarks, at least one of the plurality of the watermarks being associated with each of a plurality of user IDs [*paragraph 25, proof mark or watermark must exist in memory in order to be applied to the original, the proof mark can be associated with each of the plurality of user IDs*];

a third memory configured to store an access right associated with each of the plurality of the user IDs [*paragraph 26, it is inherent that access rights exist for both the photographer and the user, each having a different access right*]; and

a controller [*the examiner interprets a controller to be a CPU*] configured, when one of a plurality of users requests the server to display the original data on a display of the terminal apparatus by inputting the user ID of the one of the plurality of the users [*paragraph 25, the user logs on and inputs the ID number*], to transform the original data into image data, to select the watermark associated with the user ID of the one of the

plurality of the users, to add the selected watermark to the image data, and to transmit the image data with the selected watermark to the terminal apparatus [paragraph 25, *either the proof mark (examiner considers the proof mark a watermark) or the watermark is placed on the picture and transmitted to the user for viewing*],

wherein the controller is configured to control the first printer connected to the server to print the original data without the watermark when the user requests the server to print the transmitted image data and when the access right indicates that the user is permitted to print the original data [paragraph 26, *upon order, the server sends the order to the finishing lab, where it is printed without a watermark*], and

Wise inherently discloses a terminal in which the user logs onto a site to view his photographs [paragraph 25]. Wise does not disclose wherein the terminal apparatus is configured to control the second printer connected to the terminal apparatus to print the transmitted image data with the selected watermark when the access right does not indicate that the user is permitted to print the original data. Kraslavsky discloses a computer connected to a printer [figure 1, *terminal 22 is connected to printer 2, it is inherent that a user on computer 22 is able to print items that are available on terminal 22*]. All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

Regarding claim 20:

Wise and Kraslavsky disclose the server according to claim 19, but they do not disclose a printing history memory that stores a printing history of printing the original data without the watermark, wherein the controller stores a printing history in the printing history memory when the original data without the watermark is printed. Examiner takes official notice that it is well known in the art that servers record transactions into a transaction log/history. This is done to settle disputes as well as track revenue. It would have been obvious to modify the server of Wise and Kraslavsky to incorporate a transaction history in order to settle disputes and track revenue [*the transaction log also serving as a printing history as the files that are purchased are the files that are printed*].

Regarding claim 21:

Wise and Kraslavsky disclose the server according to claim 19, further comprising:

a cache memory that stores the image data with the watermark [*Wise, paragraph 24, it is inherent that a server has a cache in which most recent or frequent information gets placed into*],

wherein the controller stores the image data with the watermark in the cache memory when the controller adds the watermark to the image data, and the controller forwards the image data with the watermark from the cache memory to the terminal apparatus when the original data is requested in association with the same user ID [*Wise, paragraph 24, it is inherent that the image data with the watermark will be in the cache when it is being used by the server*].

Claims 22, 23, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wise in view of Stefik (US 2001/0008557) and Lofgren (US 2002/0154144).

Wise discloses a server connectable to a terminal apparatus and to a first printer via a network, the terminal apparatus being connected to a second printer, the server being not connected to the second printer, the server comprising:

a first memory configured to store original data without a watermark [paragraphs 24 and 26, it is inherent that the original is stored in a memory];

a second memory configured to store a first watermark associated with a document ID of the original data and with a first user ID of a user of the terminal apparatus, and a second watermark associated with the same document ID as the first watermark and with a second user ID indicating a plurality of users including the predetermined user [paragraph 25, proof mark or watermark must exist in memory in order to be applied to the original, the proof mark can be associated with each of the plurality of user IDs; paragraph 23 photo ID number];

a controller [the examiner interprets a controller to be a CPU] configured, when the user requests the server to display the original data on a display of the terminal apparatus by inputting the document ID and the first user ID of the one of the plurality of the users [paragraph 25, the user logs on and inputs the ID number].

Wise does not disclose a watermark associated with a folder ID and to determine whether the first watermark and the second watermark are stored in the second memory with respect to the document ID, folder ID, and the first user ID, to transform

the original data into image data, to select the first watermark as a priority with respect to the second watermark when the first watermark and the second watermark are stored in the second memory with respect to the document ID, folder ID, and the first user ID, to add the selected first watermark to the image data, and to transmit the image data with the selected first watermark to the terminal apparatus. Stefik discloses having the username in the watermark of a specific document along with other various information such as document name and place of printing (Figure 6, 616-617). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the system of Wise in order to include a watermark for a folder (the path name) or a user group of Stefik in order to watermark the document with a user group's or folder's watermark (path name). Wise and Stefik do not disclose selecting a first watermark as a priority with respect to the second watermark. Lofgren discloses two types of watermarks, robust and fragile. Robust watermarks survive signal processing such as scaling, rotation, cropping, editing, etc. [paragraph 46]. Fragile watermarks degrade predictably and are broken on any modification [paragraph 70]. The fragile watermark may be selected and used in addition to the robust watermark [paragraphs 70 and 71]. The examiner considers the fragile watermark to have a priority over the robust watermark as it is easily broken and detects tampering. The act of applying the watermark inherently requires the watermark to first be selected and then applied to the image data. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the system of Wise and Stefik to include robust and fragile

watermarks as disclosed by Lofgen in order to identify the image and detect unauthorized copies [*paragraph 71*].

Allowable Subject Matter

Claim 24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

The prior arts made of record do not disclose or render obvious obtaining the folder ID of the folder which includes the original data associated with the document ID when the first watermark is not stored in the second memory with respect to the document ID and the first user ID, to select the first watermark as a priority with respect to the second watermark when the first watermark and the second watermark are stored in the second memory with respect to the folder ID and the first user ID.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES TURCHEN whose telephone number is (571)270-1378. The examiner can normally be reached on MTWRF 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571)272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2139

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRT

/Kristine Kincaid/
Supervisory Patent Examiner, Art Unit 2139